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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,802	09/24/2001	Jan Loncke		8899

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FOLEY AND LARDNER
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3000 K STREET NW
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EXAMINER

SAVAGE, MATTHEW O

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 04/04/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

113

Office Action Summary	Application No.	Applicant(s)	
	09/869,802	LONCKE ET AL.	
	Examiner	Art Unit	
	Matthew O Savage	1723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

The amendment filed 1-29-03 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The concept of the bundled drawn steel fibers being delivered to the rando-feeder apparatus, or the alternate concept in which the drawn steel fibers are individualized to some extent before being delivered to the rando-feeder apparatus such as by a carding apparatus is considered new matter. In particular, any disclosure from GB 1,190,844 other than that relating to the rando-feeder apparatus is considered new matter since the reference had not been incorporated by reference in its entirety into the original application.

Applicant is required to cancel the new matter in the reply to this Office Action.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification fails to adequately disclose how to make the recited web of metal fibers. In particular, it is unclear as to how the fibers produced as disclosed in

U.S. Patent 3,379,000 are processed into the recited web. While the second paragraph of page 5 of the specification states "A first non-woven web is then produced by means of a rando-feeder apparatus which is disclosed e.g. in GB 1,190,844", such a disclosure is not considered enabling since enabling subject matter from a foreign patent document cannot be incorporated by reference into a U.S. patent application.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 561,001 to Ishibe.

With respect to claim 1, Ishibe discloses a first layer 2 and a second layer 3 each including a web of metal fibers that have been sintered, the layers being in contact, the first layer 2 having a porosity of below 55% (see line 32 of page 5) and the second layer 3 having a porosity that is at least 20% greater than the porosity of the first layer (see line 58 of page 6). The limitation of the first layer being closest to the inlet and the second layer being closest to the outlet relates to intended use and carries no patentable weight.

Concerning claim 5, Ishibe discloses a first layer 2 having at least one even surface since it is formed by a molding process.

Claim 9 relates to a method of making an apparatus and carries no patentable weight as an apparatus claim.

Claims 2-4, and 6-9 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first and second paragraphs, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 10 and 11 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, first paragraph, set forth in this Office action.

Applicant's arguments filed 1-29-03 have been fully considered but they are not persuasive.

Applicant argues that the rejection under 35 U.S.C. 112, first paragraph has been overcome by amendment of page 5 of the specification, however, it is held that such amendments constitute new matter for the reasons set forth above. Applicant argues further that one skilled in the art would know how to make the disclosed web given the disclosed term "rando-feeder" and the cited British Patent, however, it is maintained that the instant specification fails to adequately disclose how to make the web since essential details have been omitted from the instant specification including how the fibers disclosed in U.S. Patent 3,379,00 are processed prior to feeding into the rando-feeder apparatus as well as required diameter and length of the fibers required to form webs used to form the claimed product.

With respect applicant's arguments against the rejections under 35 U.S.C. 102(b), applicant argues that the layer 3 formed of short fibers disclosed by Ishibe is not a web, however, it is held that that the layer 3 constitutes a web in the sense that a continuous roll of paper of which includes short fibers can also be considered a web. Accordingly, the rejection is being maintained since no particular fiber length has been recited in the claim to patently distinguish over Ishibe.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew O Savage whose telephone number is 703-308-3854. The examiner can normally be reached on Monday-Friday, 6:00am-2:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda W. Walker can be reached on 703-308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

M. Savage
Matthew O Savage
Primary Examiner
Art Unit 1723

mos
April 3, 2003